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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/579,555	05/16/2006	Nikolai Mykola Ignatyev	MERCK-3164	3578

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EXAMINER

SHIAO, REI TSANG

ART UNIT

PAPER NUMBER

1626

MAIL DATE

DELIVERY MODE

07/28/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/579,555

Applicant(s)

IGNATYEV ET AL.

Examiner

REI-TSANG SHIAO

Art Unit

1626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 June 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date 5/16/2006
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This application claims benefit of the foreign application:
GERMANY 103 53 758.9 with a filing date 11/17/2003.
2. Amendment of claims 2-15 and addition of claim 16 in the amendment filed on June 05, 2008b is acknowledged. Claims 1-16 are pending in the application. No new matter has been found. Since the newly added claim 16 is commensurate with the scope of the invention, claims 1-16 are prosecuted in the case.

Information Disclosure Statement

3. Applicant's Information Disclosure Statement filed on May 16, 2006 has been considered. Please refer to Applicant's copy of the 1449 submitted herein.

Responses to Election/Restriction

4. Applicant's election with traverse of election of Group I claims 1-15, in part, in the reply filed on June 05, 2008 is acknowledged. The traversal is on the grounds that the Examiner is invited to suggest specific materials which he or she believes are contained in Group II. This is found persuasive, and the restriction requirement dated 5/05/2008 has been withdrawn herein.

Claims 1-16 are pending in the application. The scope of the invention of the elected subject matter is as follows.

Claims 1-16 are drawn to processes of making bis(perfluoroalkyl)-phosphinate anion thereof, and their methods of use.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 2 and 15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 2 recites the limitation "X denotes or" and "where R'=non-" is indefinite and ambiguous, see line 9 on page 2 and line 11 on page 3 respectively. It is unclear what the limitation of the variable X or R' is. Clarification is required.

Claim 15 recites the limitation "a plasticizing effect " is indefinite and ambiguous, see line 1. It is unclear what the limitation "a plasticizing effect " is. Clarification is required.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.

2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pavlenko et al. CAS: 111:194893.

Applicants claim a process of making bis(perfluoroalkyl)-phosphinate anion by reacting tris(perfluoroalkyl) phosphine oxide with an alcohol and an organic base, see claim 1.

Determination of the scope and content of the prior art (MPEP §2141.01)

Pavlenko et al. disclose a process of making bis(perfluoroalkyl)-phosphinate by reacting tris(perfluoroalkyl) phosphine oxide in the presence of methanol (i.e., an alcohol), see RX(10).

Determination of the difference between the prior art and the claims (MPEP §2141.02)

The difference between instant claims and Pavlenko et al. is that Pavlenko et al. is silent on the base used in the instant processes. Pavlenko et al. processes inherently render obviousness with the instant invention. However, the Courts have decided *per In re Boesch*, 205 USPQ 215 (1980), that the optimization of variables, such as pH (i.e., using base) and molar ratios, in a known process is prima facie obvious. Therefore, the claimed process would have been suggested to one skilled in the art. to that which is claimed in the reference.

Finding of prima facie obviousness-rational and motivation (MPEP §2142-2143)

One having ordinary skill in the art would find the claims 1-16 prima facie obvious because one would be motivated to employ the processes of Pavlenko et al. to obtain instant claimed processes, wherein bis(perfluoroalkyl)-phosphinate anions are obtained by reacting tris(perfluoroalkyl) phosphine oxide in the presence of an alcohol and an organic base. Dependent claims 2-16 are also rejected along with claim 1 under 35 U.S.C. 103(a).

The motivation to make the claimed compounds derived from the known processes of Pavlenko et al. would possess same yields to that which is claimed in the reference.

Conclusion

Any inquiry concerning this communication or earlier communications from the

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examiner should be directed to Rei-tsang Shiao whose telephone number is (571) 272-0707. The examiner can normally be reached on 8:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph K. McKane can be reached on (571) 272-0699. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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/REI-TSANG SHIAO /

Rei-tsang Shiao, Ph.D.
Primary Patent Examiner
Art Unit 1626

July 22, 2008